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In re Application of
ADE CORPORATION : DECISION ON
Application No.: 09/914,456 :
PCT No.: PCT/US00/34806 : PETITION
Int. Filing Date: 22 Dec. 2000 :
Priority Date: 30 Dec. 1999 : UNDER 37 CFR 1.47(a)
Attorney's Docket No.: ADE-066XQ999 :
For: SPECIMEN TOPOGRAPHY RECONSTRUCTION:

This decision is in response to applicants' petition under 37 C.F.R. 1.47 (a) to accept a declaration without an inventor's signature which was filed on 28 August 2001 with the Transmittal Letter requesting national stage entry under 35 U.S.C. 371. The required Rule 47(a) petition fee (\$130) will be charged applicant's deposit account (No. 23-0804) pursuant to applicant's authorization provided in the transmittal letter.

BACKGROUND

On 22 December 2000, the applicant filed international application PCT/US00/34806 claiming priority to U.S. provisional application 60174,082, filed 30 Dec. 1999. A Demand for international preliminary examination, in which the United States was elected, was made by the 19th month from the earliest claimed priority date. Accordingly, the thirty month period for paying the basic national fee in the United States in accordance with 37 CFR 1.495(b), expires at midnight on 01 July 2002 (30 June 2002 is a Sunday).

On 28 August 2001, applicants filed a Transmittal Letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee as required under 35 U.S.C. 371(c)(1) along with the present petition under 37 CFR 1.47(a) and an oath or declaration by each 37 CFR 1.47(a) inventor on his or her own behalf and on behalf of the non-signing joint inventor.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicants have satisfied items (1) and (4) above.

Regarding items (2) and (3) above, MPEP 409.03(d) (August 2001) states in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.

Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Regarding item (3) above, MPEP 409.03(e) (August 2001) states in part:

An application filed pursuant to 37 CFR 1.47 must state the last known address of the non-signing inventor.

That address should be the last known address at which the inventor customarily receives mail. See MPEP 605.03. Ordinarily, the last known address will be the last known residence of the nonsigning inventor.

Inasmuch as a nonsigning inventor is notified that an application pursuant to 37 CFR 1.47 has been filed on his or her behalf, other addresses at which the nonsigning inventor may be reached should also be given.

The supporting documentation submitted with the Rule 47(a) petition includes a statement by associate attorney Lin B. Olsen working with Charles Gagnebin (an attorney of record) asserting an attempt to secure the signature of the inventor, Alexander Belyaev as evidenced by:

- 1) forwarding of the "above-identified patent application" to applicant's agent (ADE corporate attorney Keith Long) who forwarded this paperwork to Mr. Belyaev's attorney (Larry Reece);
- 2) Mr. Reece's recommendation to Mr. Belyaev that he not sign the application and Mr. Reece's reluctance to sign a statement concerning his recommendation;
- 3) forwarding of a statement to Mr. Belyaev for his signature indicating his refusal to sign the application at this time; and
- 4) the Affidavit of Alex Belyaev stating:
 - a. his former employment by ADE Corp. and his current employment by KLA-Tencor Corp.; and
 - b. that Mr. Belyaev was recently asked by ADE to sign a patent application regarding "Specimen Topography Reconstruction" relating to work at ADE but declined to sign because of a pending lawsuit between ADE and KLA-Tencor.

The supporting documentation is deficient in several respects.

The Rule 47(a) petition clearly fails to state the last known address of the non-signing inventor as required by MPEP 409.03(e); nor is there any evidence that a copy of the application papers was sent to Mr. Belyaev's last known address. Additionally, the circumstances of the presentation of the application papers and of the refusal of the inventor to sign are not specified in the statement of facts by the person (e.g. Mr. Reece) who presented the inventor with the application papers. Further there is no evidence of record indicating that Mr. Belyaev's refusal to

sign was made in the presence of Mr. Olsen. Finally, Mr. Belyaev's Affidavit merely mentions that he was asked to sign an application titled "Specimen Topography Reconstruction" relating to his work with ADE, but fails to elucidate whether he was actually presented with the application and, if presented, the circumstances surrounding the presentation such as the person who made the presentation and the application serial number. Accordingly, there is insufficient evidence (e.g. from a person with first hand knowledge) that a *bona fide* attempt was made to present a copy of the above-identified application to the non-signing inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner of Patents, Box PCT, Washington, D.C., 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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